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PATENT

IN THE UNITED STATE PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant:

Charles G. Heisinger, Jr.

For:

METHOD AND SYSTEM FOR
TELEPHONICALLY SELECTING,
ADDRESSING, AND DISTRIBUTING
MESSAGES

Serial No.:

09/545,088

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Examiner

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APPEAL BRIEF

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Sir:

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APPEAL BRIEF ON BEHALF
OF APPELLANT:
Charles G. Heisinger, Jr.

I. **REAL PARTY IN INTEREST**

The real party in interest for this application is the Applicant and Appellant, Charles G. Heisinger, Jr.

II. **RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences pending with respect to the subject matter of the present application.

III. **STATUS OF CLAIMS**

Claims 36-40, 44 and 47-64 are now pending, claims 36, 47, 56 and 57 being independent. Claims 1-35, 41-43, 45 and 46 have been previously canceled.

IV. **STATUS OF AMENDMENTS**

No new amendments have been submitted after the last Office Action.

V. **SUMMARY OF THE INVENTION**

The present invention is a system and method for using a telephone and a code to either obtain information from a merchant or advertiser, or to order information directly from a merchant or advertiser. One embodiment provides a method and system for telephonically selecting, addressing and distributing messages that uses an automatic process to handle the task of creating and sending a message to an address that is stored in a database. In one exemplary embodiment, the body of the message is identified through use of a key code, which is supplied by an advertiser or other promoter through a media channel, such as radio, TV or print. Where the message constitutes an order to purchase, the caller's payment information, such as a credit card number, may be transmitted as part of the message (see page 3, lines 17-27).

Another embodiment provides a method and system of utilizing automatic phone number identification and entered code information for direct response purposes in mass-media advertising (see page 3, lines 30-34).

Another embodiment provides a method for selecting, addressing and distributing an electronic message through the convenience and use of a telephone (see page 4, lines 1-3).

Another embodiment provides a system and method that compares the ANI of an inbound telephone call with an address previously input by a user in a database through an Internet website. Specific stored messages are retrieved from a database by the user through the use of DTMF signals, such as those generated from a telephone keypad. Upon receiving a DTMF signal with delivery information, the message is sent either via fax, email, postal mail, time-delayed voicemail, or stored on a data table that is accessible through a website, depending on the option specified by the user. Payment information, such as a credit card number, may be included with the message (see page 4, lines 19-32).

VI. THE GROUNDS OF REJECTION

The Examiner has rejected all pending claims as follows:

Claims 36-40, 44 and 47-64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the prior art described in column 1, line 66 to column 2, line 3; column 3, lines 40-46; columns 9 and 10; column 6, lines 19-26; column 10, lines 20-31; column 12, lines 37-39; column 14, lines 23-25 and 34-49; and column 18, lines 20-23, 41-46 and 65-66 of the patent issued to Marwell, et al. (US Patent Number 6, 404,884), in view of the prior art described at column 1, lines 32-35 and column 4, line 63 to column 5, line 1 of the patent issued to Foladare, et al. (US Patent Number 6,311,210).

VII. ISSUES ON APPEAL

The issue to be resolved in this appeal is:

Whether claims 36-40, 44 and 47-64 are unpatentable under 35 U.S.C. § 103(a) over Marwell in view of Foladare.

VIII. GROUPING OF CLAIMS

The claims should be grouped as follows for purposes of this Appeal:

- (1) Claims 36-40 and 44 stand and fall together.
- (2) Claims 47 and 55 stand and fall together.
- (3) Claim 56 is separately grouped and argued.
- (4) Claims 57 and 64 stand and fall together.

IX. ARGUMENT

(1) Argument Summary

The reasoning provided in support of the rejection of claims 36-40, 44 and 47-64 under 35 U.S.C. § 103(a) as being unpatentable over Marwell in view of Foladare fails to establish *prima facie* obviousness. Generally, the deficiencies of the rejection are that:

- a. The rejection attributes certain claimed features to the primary reference, Marwell, which a detailed reading of the reference reveals are not taught therein. These features are not shown, taught, or suggested in the secondary reference;
- b. When the nature and purpose of the system disclosed by Marwell is recognized, it is evident that there is no suggestion or motivation to modify the prior art of Marwell in a manner asserted by the rejection; and
- c. By asserting that certain modifications to the prior art shown in Marwell would have been obvious without a proper suggestion or motivation in the applied references or elsewhere to make the asserted modifications, the rejection appears to rely on impermissible hindsight reason. At least these deficiencies exist for the rejection of all claims.

(2) The Legal Requirements of Prima Facie Obviousness

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of the prior art must be supported by some teaching, suggestion or motivation in the applied references or in knowledge generally available to one skilled in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The prior art must suggest the desirability of the modification in order to establish a *prima facie* case of obviousness. In re Brouwer, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). It can also be said that the

prior art must collectively suggest or point to the claimed invention to support the findings of obviousness. In re Hedges, 783 F.2d 1038, 1041, 228 USPQ, 685, 687 (Fed. Cir. 1986); In re Ehrreich, 590 F.2d 902, 908-909, 200 USPQ 504, 510 (C.C.P.A. 1979).

To establish obviousness based on the combination of elements disclosed in the prior art there must be some motivation, suggestion or teaching, and the desirability of making the specific combination that was made by the Appellant. The motivation, suggestion or teaching may come explicitly from the statements in the prior art, the knowledge of one of ordinary skill in the art or, in some cases, the nature of the problem to be solved. In re Dembiczak, 50 USPQ2d. 1614 (Fed. Cir. 1999). In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must provide particular findings as to why the two pieces of prior art are combinable. See Dembiczak, 50 USPQ2d at 1617. Broad conclusionary statements standing alone are not "evidence."

- (3) The rejection fails to establish *prima facie* obviousness of independent claims 36, 47, 56 and 57, and dependent claims 37-40, 44, 48-55 and 58-64

The remaining claims contain four independent claims 36, 47, 56 and 57. Independent claim 36 is directed to a method of addressing an electronic message. The method of claim 36 comprises:

36. A method of addressing an electronic message, comprising the steps of:

providing a first database containing stored telephone numbers and user addresses for each of the stored telephone numbers;

providing a second database containing identification codes and product information corresponding to each of the identification codes;

receiving a telephone call from a user including one of the identification codes;

identifying the received telephone number from the telephone call;

retrieving the user address from the first database by comparing the received telephone number with the stored telephone numbers;

retrieving the product information corresponding to the received identification code;

addressing the electronic message according to the retrieved address; and

sending at least a portion of the retrieved product information via the electronic message, wherein the first and second databases are used to create the electronic message.

Independent claim 47 is likewise directed to a system for addressing an electronic message. The system of claim 47 comprises:

47. A system for addressing an electronic message, comprising:

a first database containing stored telephone numbers and user information corresponding to each of the stored telephone numbers;

a second database containing identification codes and addressing information corresponding to each of the identification codes;

a receiver for accepting a telephone call from a user including one of the identification codes;

an ANI for identifying the received telephone number from the telephone call;

a processor; and

wherein the first and second databases are used to create the electronic message and the processor retrieves the user information from the first database by comparing the received telephone number with the stored telephone numbers, retrieves the addressing information corresponding to the received identification code, addresses the electronic message according to the retrieved addressing information, and sends at least a portion of the retrieved user information via the electronic message.

Independent claim 56 is also directed to a method of addressing an electronic message. The method of claim 56 comprises:

56. A method of addressing an electronic message, comprising the steps of:

providing a first database containing stored telephone numbers and corresponding payment instructions and user addresses;

providing a second database containing identification codes and addressing information corresponding to each of the identification codes;

receiving a telephone call from a user including one of the identification codes;

identifying the received telephone number from the telephone call using an ANI;
retrieving the user information from the first database by comparing the received telephone number with the stored telephone numbers;
retrieving the addressing information corresponding to the received identification code;
addressing the electronic message according to the retrieved addressing information; and sending the payment instructions via the electronic message, wherein the first and second databases are used to create the electronic message.

Independent claim 57 is directed to a method of purchasing a product. The method of claim 57 comprises:

57. A method of purchasing a product, comprising the steps of:

providing a first database containing stored telephone numbers and user information corresponding to each of the stored telephone numbers;

providing a second database containing identification codes and product information corresponding to each of the identification codes;

receiving a telephone call from a user including one of the identification codes;

identifying the received telephone number from the telephone call;

retrieving the user information from the first database by comparing the received telephone number with the stored telephone numbers;

retrieving the product information corresponding to the received identification code; and

purchasing the product based upon the user information retrieved from the first database and the product information retrieved from the second database, wherein the first and second databases are used to create the electronic message.

In rejecting independent claims 36, 47, 56 and 57, and dependent claims 37-40, 44, 48-55 and 58-64, the Examiner relies on the primary reference, Marwell, as allegedly disclosing a method of addressing an electronic message that includes most of the claimed elements. The Examiner acknowledges that Marwell fails to disclose the steps of sending at least a portion of the retrieved user information via electronic message, and wherein the first and second databases are used to create the electronic message.

Nonetheless, the Examiner alleges on page 6 of the Office Action that Foladare teaches a separate device for determining the portions of the electronic mail message to be sent for each of the receiving party's electronic mail receiving devices 120-150 and to compile these portions into a message to be sent to the electronic mail receiving devices. The Examiner further alleges that it would have been obvious to combine the teachings of Marwell and Foladare with the steps of sending at least a portion of the retrieved user information via the electronic message, and wherein the first and second databases are used to create the electronic message. The Examiner alleges that such modification would allow the teachings of Marwell and Foladare to improve the accuracy and the reliability of the method and system for telephonically selecting, addressing and distributing messages, and to provide a centralized electronic mail service method and apparatus in which selected portions of an electronic mail message are sent to each of a subscriber's electronic mail addresses.

Appellant points out that there is no motivation to combine the "features" in Foladare with the system shown in Marwell. The prior art disclosed in Marwell shows a personalized assistance system and method. The Marwell system and method is a personalized directory assistance system that allows a user to speak with a customer service representative by dialing an easy-to-remember telephone number on their phone. Specialized telephone equipment routs the call to the costumer service representative, and the user's personal contact list is made available to the customer service representative (CSR). The CSR searches the user's personal contact list in accordance with the user's request. Thereafter, the CSR generates a call completion string and sends it to the telephony equipment so that the user's telephone call is forwarded to the requested recipient.

Marwell relies on a human CSR as an integral part of the system. Marwell rejects speech recognition as "cumbersome" and "difficult to use" (see Marwell column 2, lines 1-20). Marwell is classified exclusively in class 379, which is the telephone art.

Foladare, on the other hand, shows a method and apparatus for sending an electronic mail message to a receiving party. Foladare provides a centralized electronic mail apparatus and method in which a message is sent to each of a subscriber's electronic mail receiving devices. When a sending party wishes to send an electronic mail message to a receiving party, the sending party creates the electronic mail message along with an attachment using his user devices and sends the electronic mail message to the centralized electronic mail apparatus. The centralized

electronic mail apparatus receives the electronic mail message and retrieves profile information from a profile database corresponding to the receiving party. Based on the profile information, the centralized electronic mail device further determines the receiving party's electronic mail receiving devices to which the electronic mail message is to be sent. Further, the centralized electronic mail apparatus determines the portions of the electronic mail message that are to be sent to each of the electronic mail receiving devices. The centralized electronic mail apparatus then sends the portions of the electronic mail message to the electronic mail receiving devices and monitors them to determine if the receiving party has retrieved the electronic mail message from any of the electronic mail receiving devices. Foladare is classified exclusively in class 703, which is multi-computer data transferring.

Foladare teaches an automated electronic mail message routing system that receives an incoming electronic mail message and automatically routes it to the recipient's receiving devices, whereas Marwell teaches a human-operated telephone switchboard to rout a user's telephone call to a selected recipient. There is nothing in either patent to suggest or teach combining the two diverse arts to come up with the present invention. In addition, Marwell teaches away from the combination because it relies exclusively on a human operator and rejects the idea of using an integrated computer system. Therefore, Appellant submits that the rejection fails to establish *prima facie* obviousness of the pending claims over Marwell in view of Foladare.

(4) The Combination of Marwell and Foladare fails to render the pending claims obvious

Even if properly combinable, the combination fails to render the pending claims obvious. Marwell does not disclose (a) addressing an electronic message; (b) sending information back to the user in an electronic format using an address that is in the first database; (c) using both databases to create an electronic message to send to a merchant for purchasing goods and services; and (d) receiving a telephone call including one of the identification codes, identifying the received telephone number from the call, and retrieving the user address from the first database by comparing the received telephone number with the stored telephone numbers. Furthermore, Foladare does not teach the features missing from the Marwell patent. Thus, the combination of Marwell and Foladare fails to teach or suggest at least these features.

With respect to claims 36-40 and 44, independent claim 36 recites "a method of addressing an electronic message... receiving a telephone call from a user including one of the

identification codes; identifying the received telephone number from the telephone call; retrieving the user address from the first database by comparing the received telephone number with the stored telephone numbers;... addressing the electronic message according to the retrieved address; and sending at least a portion of the retrieved product information via the electronic message, wherein the first and second databases are used to create the electronic message.”

The Examiner alleges that Marwell discloses a method of addressing an electronic message, relying on column 14, line 23-25. Marwell is only concerned with routing a telephone call, and not with addressing any electronic messages. A close inspection of the art relied on by the Examiner reveals that Marwell does not address an electronic message. The Examiner’s cited support relates to registration screen 86, wherein the user enters identifying information including an electronic mail address for the user. At no point in Marwell is there any discussion of actually addressing an electronic message using the stored electronic mail address, nor does Marwell discuss sending a message to the user.

Claim 36 also recites “addressing the electronic message according to the retrieved address.” The Examiner alleges that Marwell teaches this, relying on column 12, line 37-39. However, the portion of Marwell relied on by the Examiner deals with the user updating his own personal contact list by sending electronic mail from the user’s terminal 10 to a web server 68 describing the desired changes of the user’s contact list in detail. This is unrelated to the claimed steps of receiving a telephone call from a user, identifying the received telephone number, retrieving the user’s address from a first database by comparing the received telephone number with the stored telephone numbers and subsequently addressing the electronic message according to the retrieved address. Nowhere in Marwell is it disclosed that the system or apparatus addresses an electronic message and sends that message to a retrieved address for the user. Marwell merely discloses a user addressing his own electronic message to the system and sending the electronic message with updates to the user’s contact list to the system manually.

Claim 36 recites providing “a first database containing stored telephone numbers and user addresses for each of the stored telephone numbers; providing a second database containing identification codes and product information corresponding to each of the identification codes;... wherein the first and second databases are used to create the electronic message.” The Examiner alleges that Marwell teaches providing a first database containing stored telephone numbers and

user information corresponding to each of the stored telephone numbers, relying on columns 1-2, lines 66-3. However, that portion of Marwell, deals with the background related to searching for and accessing contact data. The Examiner alleges that Marwell provides a second database containing identification codes and addressing information corresponding to each identification code relying on column 6, lines 19-26. First, the claims recited provide a second database containing identification codes and product information corresponding to each of the identification codes. Thus, the rejection as applied fails to recite the features of the claim. Next, a close inspection of column 6, line 19-26 reveals that Marwell discloses a single database containing personal contact list tables. Nowhere in Marwell does it disclose a second database, or even a database containing identification codes and product information corresponding to each of the identification codes.

Claim 36 recites receiving “a telephone call from a user including one of the identification codes; identifying the received telephone number from the telephone call; and retrieving the user address from the first database by comparing the received telephone number with the stored telephone numbers.” The Examiner alleges that Marwell teaches receiving a telephone call from a user including one of the identification codes relying on column 3, lines 40-43. However, close inspection of this reveals that it merely indicates the user contacts a service for searching a database for desired information by dialing a telephone number associated with the service. Marwell does not mention receiving a telephone call including an identification code.

The Examiner attributes certain claimed features to the primary reference, Marwell, which a detailed reading of the reference reveals are not taught therein. Further, these features are not shown, taught or suggested in the secondary reference, Foladare.

The Examiner explicitly acknowledges that Marwell does not disclose sending at least a portion of the retrieved product information via the electronic message (to the user address), wherein the first and second databases are used to create the electronic message. The Examiner relies on Foladare to supply this missing teaching, specifically citing columns 4-5, lines 63-1 of Foladare. As can be seen by a detailed reading of Foladare, including the specific citation relied upon by the Examiner, Foladare teaches determining portions of an electronic message to be sent to each of the receiving party's electronic mail receiving devices 120-150. In Foladare, the recipient's address is already known and entered in by the user (sending party). The centralized

electronic mail apparatus just adds an attachment or further information to the already existing electronic mail message. This electronic mail message is sent to the recipients, not the user.

For at least the reasons set forth above, Appellant respectfully submits that claim 36 defines patentable subject matter. Claims 37-40 and 44 depend from claim 36. Therefore, Marwell, alone or in combination with Foladare, fails to render these claims obvious for at least the reasons given with respect to claim 36 as well as their additional features.

The remaining independent claims, claims 47, 56 and 57, recite similar features. Accordingly, Appellant respectfully submits that these claims, as well as their dependent claims, define patentable subject matter.

X. CONCLUSION

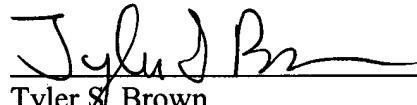
For the reasons specifically set forth above, the outstanding rejection set forth in the Office Action should be reversed.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,
KRAMER & AMADO, P.C.

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5/6/04



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XI. APPENDIX

Claims

36. A method of addressing an electronic message, comprising the steps of:
 - providing a first database containing stored telephone numbers and user addresses for each of the stored telephone numbers;
 - providing a second database containing identification codes and product information corresponding to each of the identification codes;
 - receiving a telephone call from a user including one of the identification codes;
 - identifying the received telephone number from the telephone call;
 - retrieving the user address from the first database by comparing the received telephone number with the stored telephone numbers;
 - retrieving the product information corresponding to the received identification code;
 - addressing the electronic message according to the retrieved address; and
 - sending at least a portion of the retrieved product information via the electronic message, wherein the first and second databases are used to create the electronic message.
37. The method as recited in claim 36, wherein the electronic message is a fax.
38. The method as recited in claim 36, wherein the electronic message is an e-mail.
39. The method as recited in claim 36, wherein the electronic message is a voice mail.
40. The method as recited in claim 36, wherein the user information includes payment instructions and the payment instructions are sent via the electronic message.
44. The method as recited in claim 36, wherein the electronic message includes an advertisement or an order confirmation.
47. A system for addressing an electronic message, comprising:

a first database containing stored telephone numbers and user information corresponding to each of the stored telephone numbers;

a second database containing identification codes and addressing information corresponding to each of the identification codes;

a receiver for accepting a telephone call from a user including one of the identification codes;

an ANI for identifying the received telephone number from the telephone call;

a processor; and

wherein the first and second databases are used to create the electronic message and the processor retrieves the user information from the first database by comparing the received telephone number with the stored telephone numbers, retrieves the addressing information corresponding to the received identification code, addresses the electronic message according to the retrieved addressing information, and sends at least a portion of the retrieved user information via the electronic message.

48. The system of claim 47, wherein the electronic message is a fax.

49. The system of claim 47, wherein the electronic message is an e-mail.

50. The system of claim 47, wherein the electronic message is a voice mail.

51. The system of claim 47, wherein the user information includes payment instructions and the payment instructions are sent via the electronic message.

52. The system of claim 47, wherein the user information includes a user address and the user address is sent via the electronic message.

53. The system of claim 52, further including a second processor and wherein the second processor retrieves the user address from the electronic message.

54. The system of claim 53, wherein the second processor sends a second electronic message to the user.

55. The system of claim 54, wherein the second electronic message includes an advertisement.

56. A method of addressing an electronic message, comprising the steps of:

 providing a first database containing stored telephone numbers and corresponding payment instructions and user addresses;

 providing a second database containing identification codes and addressing information corresponding to each of the identification codes;

 receiving a telephone call from a user including one of the identification codes;

 identifying the received telephone number from the telephone call using an ANI;

 retrieving the user information from the first database by comparing the received telephone number with the stored telephone numbers;

 retrieving the addressing information corresponding to the received identification code;

 addressing the electronic message according to the retrieved addressing information; and sending the payment instructions via the electronic message, wherein the first and second databases are used to create the electronic message.

57. A method of purchasing a product, comprising the steps of:

 providing a first database containing stored telephone numbers and user information corresponding to each of the stored telephone numbers;

 providing a second database containing identification codes and product information corresponding to each of the identification codes;

 receiving a telephone call from a user including one of the identification codes;

 identifying the received telephone number from the telephone call;

 retrieving the user information from the first database by comparing the received telephone number with the stored telephone numbers;

 retrieving the product information corresponding to the received identification code; and

purchasing the product based upon the user information retrieved from the first database and the product information retrieved from the second database, wherein the first and second databases are used to create the electronic message.

58. The method as recited in claim 57, wherein user information includes address information.

59. The method as recited in claim 58, wherein address information includes shipping information.

60. The method as recited in claim 58, wherein address information includes billing information.

61. The method as recited in claim 57, wherein user information includes payment instructions

62. The method as recited in claim 61, wherein payment instructions include credit card information

63. The method as recited in claim 57, further comprising the step of shipping the product.

64. The method as recited in claim 59, wherein shipping information includes delivery method information